

REMARKS

35 U.S.C. § 112 Second Paragraph Rejection of Claims

In the 31 March 2008 Office Action claims 35 – 68 are rejected under 35 U.S.C. §112 second paragraph. The Assignee will respectfully traverse the §112 second paragraph rejections of each claim in several ways. First, by noting that the Office Action has failed to establish a prima facie case that the claims do not meet the requirements of §112 second paragraph. Second, by noting that the claim rejections based on assertions of alleged indefiniteness are not in compliance with the Administrative Procedures Act and are therefore moot.

The first way the Assignee will traverse the 35 U.S.C. §112 second paragraph rejection of claims 35 – 68 will be by noting that the arguments presented by the Examiner fail to establish the prima facie case required to sustain a §112 second paragraph rejection. *MPEP 2173.02 states that: definiteness of claim language must be analyzed, not in a vacuum, but in light of:*

- (A) The content of the particular application disclosure;*
- (B) The teachings of the prior art; and*
- (C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.*

In reviewing a claim for compliance with 35 U.S.C. 112, second paragraph, the examiner must consider the claim as a whole to determine whether the claim apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. 112, second paragraph, by providing clear warning to others as to what constitutes infringement of the patent. See, e.g., Solomon v. Kimberly-Clark Corp., 216 F.3d 1372, 1379, 55 USPQ2d 1279, 1283 (Fed. Cir. 2000). See also In re Larsen, No. 01-1092 (Fed. Cir. May 9, 2001). In the case of claims 1, 49 and 61 the Examiner has failed to establish the prima facie case that the specification does not meet the requirements of §112 second paragraph in four ways for every rejected claim. The four ways are:

1. by failing to interpret the claims in light of the specification,
2. by failing to provide any evidence that someone of average skill in the relevant arts would have difficulty interpreting the claims,
3. by failing to establish that the limitation(s) in the claims fail to describe the invention and/or
4. by failing to consider the claim as a whole.

As noted previously, the second way the Assignee will respectfully traverse the §112 second paragraph rejections of claims 35 – 68 is by noting that the assertions regarding the alleged indefiniteness of the claims are not in compliance with the requirements of the Administrative Procedures Act and are therefore moot. In *Dickinson v. Zurko*, 119 S. Ct. 1816, 50 USPQ2d 1930 (1999), the Supreme Court held that the appropriate standard of review of PTO findings are the standards set forth in the Administrative Procedure Act ("APA") at 5 U.S.C. 706 (1994). The APA provides two standards for review – an arbitrary and capricious standard and a substantial evidence standard. The Assignee respectfully submits that discussion in the preceding paragraphs clearly shows that the instant Office Action fails to provide even a scintilla of evidence to support the allegation that the specification does not meet the requirements of §112 second paragraph and that as a result it fails to meet the substantial evidence standard. The Assignee respectfully submits that the 31 March 2008 Office Action also fails to pass the arbitrary and capricious test because the Examiner has not provided any evidence of relevant fact finding that can be connected to the rejections contained in the Office Action. The Assignee notes that the Examiner has not provided a requested affidavit with documentation regarding the presence of a level of skill in the art established by the Supreme Court as being required to make meaningful statements in this regard. The Assignee notes that there are still other ways in which these rejections can be shown to be arbitrary, capricious and discriminatory.

35 U.S.C. § 112 First Paragraph Rejection of Claims

In the 31 March 2008 Office Action claims 35 – 68 are rejected under 35 U.S.C. §112 first paragraph. These rejections appear to rely on the Examiner's assertion that cross referenced application 09/994,739 is an unrelated application. The Assignee traverses these claim rejections by noting that: application 09/994,720 and 09/994,739 both contain all the material previously incorporated by amendment and that the originally filed specification for the instant application clearly identifies applications 09/994,720 and 09/994,739 as a cross referenced applications that were incorporated by reference in the first paragraph of page 1, line 25 of page 6 and line 5 of page 15. There is a typo as the last few words of the first paragraph on page should be amended to read "the disclosures of which is are incorporated herein by reference." The Assignee has been advised by outside counsel that correcting this typo is a formality which the Examiner can easily handle.

Request for affidavits under 37 C.F.R. 1.104

Because the 31 March 2008 Office Action contains no evidence, the claim rejections rely entirely on the personal knowledge of the Examiner and/or one or more other employees of the Office. 37 C.F.R. 1.104 provides that:

When a rejection in an application is based on facts within the personal knowledge of an employee of the Office, the data shall be as specific as possible, and the reference must be supported, when called for by the applicant, by the affidavit of such employee, and such affidavit shall be subject to contradiction or explanation by the affidavits of the applicant and other persons.

Accordingly, the Assignee requests that an affidavit detailing the facts within the personal knowledge of any employee(s) of the Office that were used to support the statement that application 09/994,739 is not a related application.

The Assignee is hereby also requesting that an affidavit detailing the reason or reasons why process optimization applications from large companies are statutory and are classified as artificial intelligence applications (class 706) while the instant application is classified as a business method (class 705) application.

Statement under 37 CFR 1.111

37 CFR 1.111 requires that the basis for amendments to the claims be pointed out after consideration of the references cited or the objections made. 37 CFR 1.111 states in part that:

In amending in response to a rejection of claims in an application or patent undergoing reexamination, the applicant or patent owner must clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. He or she must also show how the amendments avoid such references or objections.

The Assignee notes that this requirement is not relevant to the instant application because, as detailed above, there are no references or objections to avoid. Having said that, the Assignee notes that the primary reasons the prior set of claims were amended to put the claims in final form for allowance and issue.

Reservation of rights

The Assignee hereby explicitly reserves the right to present the previously modified and/or canceled claims for re-examination in their original format. The cancellation or modification of pending claims to put the instant application in a final form for allowance and issue is not to be construed as a surrender of subject matters covered by the original claims before their cancellation or modification.

Conclusion

The pending claims are of a form and scope for allowance. Prompt notification thereof is respectfully requested.

Respectfully submitted,
Asset Trust, Inc.

/B.J. Bennett/

B.J. Bennett, President
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